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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/919,248	07/31/2001	John Holden Bickford	RSW920010143US1	2799

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11/23/2005

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EXAMINER

PYZOCHA, MICHAEL J

ART UNIT	PAPER NUMBER
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2137

DATE MAILED: 11/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/919,248

Applicant(s)

BICKFORD ET AL.

Examiner

Michael Pyzocha

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 October 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 3-14 are pending.
2. Appeal Brief filed 10/24/2005 has been received and considered.

Claim Objections

3. Claims 10-11 objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. These claims recite reading memory but fail to do anything with the memory read or even say what information is read at the specific address. Therefore no patentable weight is given to reading memory without other steps.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 10-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point

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out and distinctly claim the subject matter which applicant regards as the invention.

6. Claims 10-11 rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: telling what is read from memory at the address and what is done with that information.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 3-9, 12-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Lindeman et al (US 20030009698).

As per claim 3, Lindeman discloses an authentication method for electronic mail, comprising the steps of: preparing electronic mail for sending from an originator to a recipient

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(see paragraphs 98 and 101); reading from a memory an authentication key associated with the originator; including the authentication key in an open field of the electronic mail (see paragraph 31); and sending the electronic mail from the originator to the recipient.

As per claim 4, Lindeman discloses the open field is the subject line (see paragraphs 29 and 31).

9. As per claim 5, Lindeman discloses the authentication key associated with the originator is further associated with the recipient (see paragraph 31).

As per claim 6, Lindeman discloses an authentication method for electronic mail, comprising the steps of: receiving electronic mail from an originator (see paragraph 98); determining whether an authentication key is present in an open field of the electronic mail; when an authentication key is present, determining whether the authentication key is associated with the originator (see paragraph 101); and rejecting the electronic mail when the authentication key is not associated with the originator (see paragraphs 102 and 103).

10. As per claim 7, the modified Fischer, Bando et al and Davis et al system discloses the open field is the subject line (see paragraph 29 and 31).

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As per claim 8, Lindeman discloses an authentication method for electronic mail, comprising the steps of: receiving electronic mail from an originator (see paragraph 98); determining whether an authentication key is expected to be present in an open field of the electronic mail; when an authentication key is expected to be present, determining whether an authentication key is present; and rejecting the electronic mail when the authentication key is not present (see paragraphs 103-106).

As per claim 9, Lindeman discloses an authentication method for electronic mail, comprising the steps of: receiving electronic mail from an originator (see paragraph 98); determining whether an authentication key is expected to be present in an open field of the electronic mail; when an authentication key is expected to be present, determining whether the authentication key is present; when the authentication key is not present, rejecting the electronic mail (see paragraphs 103-106); and when the authentication key is present, determining whether the authentication key is associated with the originator, accepting the electronic mail when the authentication key is associated with the originator, and rejecting the electronic mail when the authentication key is not associated with the originator (see paragraphs 101-103).

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As per claim 12, Lindeman discloses preparing electronic mail for sending from an originator to a recipient (see paragraphs 98 and 101); and sending the electronic mail from the originator to the recipient; determining whether an authentication key is present in an open field of the electronic mail; when an authentication key is present, determining whether the authentication key is associated with the originator (see paragraph 101); and rejecting the electronic mail when the authentication key is not associated with the originator (see paragraphs 102 and 103).

As per claim 13, Lindeman discloses an authentication method for electronic mail, comprising the steps of: receiving the electronic mail from an originator, the electronic mail having been previously prepared for sending from an originator to a recipient (see paragraph 98); determining whether an authentication key is expected to be present in an open field of the electronic mail; when an authentication key is expected to be present, determining whether the authentication key is present; and rejecting the electronic mail when the authentication key is not present in the open field of the electronic mail (see paragraphs 103-106).

As per claim 14, the modified Fischer, Bando et al, Davis et al and MSA system discloses an authentication method for

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electronic mail having a subject line, comprising the steps of: receiving the electronic mail from an originator the electronic mail having been previously prepared for sending from an originator with a source identifier to a recipient with a destination identifier (see paragraph 98); determining whether an authentication key is expected to be present in an open field of the electronic mail; then the authentication key is not expected to be present, accepting the electronic mail; when the authentication key is expected to be present, determining whether the authentication key is present; when the authentication key is present, determining whether the authentication key is associated with the originator and further associated with the recipient; accepting the electronic mail when the authentication key is determined to be associated with the originator and the recipient; rejecting the electronic mail when the authentication key is determined not to be associated with the originator and further associated with the recipient; and, when the authentication key is not present, rejecting the electronic mail (see paragraphs 103-106 and figure 7).

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Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fischer and further in view of Bando et al (US 6405244).

As per claim 3, Fischer discloses an authentication method for electronic mail, comprising the steps of: preparing electronic mail for sending from an originator to a recipient; including the authentication key in an open field of the electronic mail; and sending the electronic mail from the originator to the recipient.

Fischer fails to disclose reading from a memory an authentication key associated with the originator.

However, Bando et al teaches reading authentication information associated with the originator (see column 5 line 54 through column 6 line 6).

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At the time of the invention it would have been obvious to a person of ordinary skill in the art to use Bando et al's method of reading authentication information in the email authentication method of Fischer.

Motivation to do so would have been to decide that falsification or alteration has not been performed (see Bando et al column 6 lines 1-6).

As per claim 4, the modified Fischer and Bando et al system discloses the open field is the subject line (see Fischer paragraph 25).

Response to Arguments

13. In view of the appeal brief filed on 06/28/2005, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth above.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new

amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

14. Applicant's arguments filed 10/24/2005 have been fully considered but they are not persuasive. Applicant argues: Fischer in view of Bando fails to teach or suggest the claimed limitation of "reading from a memory an authentication key associated with the originator", however the public key, not the private key of Bando, is the authentication key associated with the originator.

It is also noted that Applicant argued inherency cannot be used in a rejection under 35 USC 103, however this is untrue. Applicant is directed to MPEP 2112.

15. Applicant's arguments with respect to claims 3-14 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Eguchi (US 20020054365) teaches rejecting an email when authentication information is not present and L'Heureux (US 6697942) teaches emails including authentication information.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Pyzocha whose telephone number is (571) 272-3875. The examiner can normally be reached on 7:00am - 4:30pm first Fridays of the bi-week off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MJP


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